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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,326	07/10/2003	Bastiaan Driehuys	PM0026 DIV	2824
7590 Amersham Health, Inc. 101 Carnegie Center Princeton, NJ 08540				
07/23/2008				
EXAMINER				
JONES, DAMERON LESTY				
ART UNIT		PAPER NUMBER		
1618				
MAIL DATE		DELIVERY MODE		
07/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/617,326

**Applicant(s)**

DRIEHOUS ET AL.

**Examiner**

D. L. Jones

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/28/08; 7/11/08; & 7/17/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 64-69 and 80 is/are pending in the application.
- 4a) Of the above claim(s) 80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges receipt of the amendment filed 4/28/08 wherein claims 1-63, 70-79, and 81-88 were canceled and claims 64 and 69 were amended. Also, the Examiner acknowledges receipt of the acceptable terminal disclaimers filed 7/11/08. In addition, the Examiner acknowledges receipt of the miscellaneous letter filed 7/17/08 submitting a copy of the power of attorney.

**Note:** Claims 64-69 and 80 are pending.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

2. The Applicant's arguments and/or amendment filed 4/28/08 to the rejection of claims 64-69 made by the Examiner under double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

### **Double Patenting Rejections**

All outstanding double patenting rejections **except** that over 10/761,794 is  
WITHDRAWN.

**Note:** It is duly noted that while the instant application was filed prior to 10/761,794, if the instant application only contained a provisional rejection over 10/761,794, according to MPEP 804, the Examiner would allow the earlier application to issue and require a terminal disclaimer in the later filed application. However, since 10/761,794 is now an issued patent, US Patent No. 7,357,917, the rejection is no longer a provisional rejection.

## **WITHDRAWN CLAIM**

3. Claim 80 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

## **NEW GROUNDS OF REJECTIONS**

### **Double Patenting Rejections**

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 64-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 7,357,917. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods involving administering a therapeutic agent to a subject (see patented claim 1, for example), generating and image, and evaluating the cardiac image data. While the steps are not the same, a skilled practitioner in the art would recognize that in both cases, (1) the effect of the therapeutic agent administered to the subject is being evaluated and (2) the steps of the instant invention are encompassed by those of the patent which contain more details as to how the NMR data is obtained and analyzed. Thus, the instant invention encompasses the patented invention.

6. Claims 64-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 6,346,229. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods involving administering a medication to a subject (see patented claim 23, for example), generating and image, and evaluating the cardiac and/or pulmonary image data. While the steps are not the

same, a skilled practitioner in the art would recognize that in both cases, (1) the effect of the medication administered to the subject is being evaluated and (2) the steps of the instant invention are encompassed by those of the patent which contain more details as to how the NMR data is obtained and analyzed. Thus, the instant invention encompasses the patented invention.

7. Claims 64-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,696,040. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods involving administering a therapeutic agent to a subject (see patented claim 25, for example), generating and image, and evaluating the cardiac image data. While the steps are not the same, a skilled practitioner in the art would recognize that in both cases, (1) the effect of the therapeutic agent administered to the subject is being evaluated and (2) the steps of the instant invention are encompassed by those of the patent which contain more details as to how the NMR data is obtained and analyzed. Thus, the instant invention encompasses the patented invention.

#### **COMMENTS/NOTES**

8. In order to clarify the instant invention, Applicant is respectfully requested to replace 'is one of a cardiac condition and a pulmonary condition' (in claims 64 and 69, lines 5 and 2, respectively) with 'is selected from a cardiac or a pulmonary condition'.

9. Applicant is again respectfully requested to cancel the non-elected subject matter.

**Note:** Claim 80 is directed to non-elected subject matter.

10. The claims are allowable over the prior art of record because the prior art neither anticipates nor renders obvious a method having the limitations as set forth in independent claim 64. The closest art is Applicant's own work which has been cited in the various double patenting rejections.

**11. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. Jones/  
Primary Examiner  
Art Unit 1618

July 18, 2008